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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,448	11/16/2005	Nikolay Khanzhin	427-US-PCT	1600
45821	7590	09/09/2009	EXAMINER	
LUNDBECK RESEARCH USA, INC. ATTENTION: STEPHEN G. KALINCHAK, LEGAL 215 COLLEGE ROAD PARAMUS, NJ 07652			KOSACK, JOSEPH R	
		ART UNIT	PAPER NUMBER	
		1626		
		MAIL DATE	DELIVERY MODE	
		09/09/2009	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/550,448	KHANZHIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph R. Kosack	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 July 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13,21 and 25-29 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3,6-9,11-13,21,25-27 and 29 is/are rejected.  
 7) Claim(s) 4,5,10 and 28 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

Claims 1-13, 21, and 25-29 are pending in the instant application.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2009 has been entered.

### ***Previous Claim Objections***

Claims, 2, 4, 5, 10, and 28 were previously objected to as being dependent upon a rejected base claim. As claims 4, 5, 10, and 28 are still dependent on a rejected base claim, the objection is maintained. The objection to claim 2 is withdrawn as a rejection can be made on claim 2.

### ***Previous Claim Rejections - 35 USC § 102***

Claims 1, 3, 6-9, 11-13, 21, 25-27, and 29 were previously rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (WO 2001/68585).

The Applicant has deleted the anticipated subject matter, and the rejection is withdrawn.

### ***Claim Objections***

Claims 4, 5, 10, and 28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

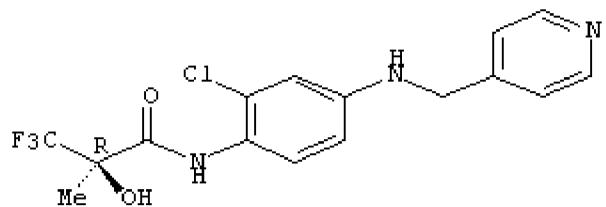
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 6-9, 11-13, 21, 25-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butlin et al. (WO 99/62506) in view of Patani et al. (*Chemical Reviews*, 1996, 3147-3176).

Determination of the scope and content of the prior art (MPEP §2141.01)

Butlin et al. teach a compound of the formula



which corresponds to the claims where s is 0, R2 is hydrogen, X is C=O, q is 0, R3 is halo-hydroxy-C1-6-alkyl, R1 is hydrogen, Y is



and k is 0. See page 159, Example 393.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Butlin et al. do not teach where R3 is halo-C1-6-alkyl instead of halo-hydroxy-C1-6-alkyl.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Patani et al. teach that methyl and hydroxyl are bioisosteres of each other. See page 3153, especially Table 12 and Figure 14. The motivation to make the change and reasonable expectation of success is provided by Patani et al. which teaches that "bioisosterism represents one approach used by the medicinal chemist for the rational modification of lead compounds into safer and more clinically effective agents. . . The

prevalence of the use of bioisosteric replacements in drug design need not be emphasized." See page 3147.

Thus, the claimed invention as a whole was *prima facie* obviousness over the combined teachings of the prior art.

***Conclusion***

Claims 1-3, 6-9, 11-13, 21, 25-27, and 29 are rejected. Claims 4, 5, 10, and 28 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Joseph R Kosack/  
Examiner, Art Unit 1626